

Attorney Docket No.: ISPH-0614  
Inventors: Wu et al.  
Serial No.: 09/992,738  
Filing Date: November 14, 2001  
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#### **REMARKS**

Claims 1 and 10-13 are pending in the instant application. Claims 11-13 have been allowed. Claims 1 and 10 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

#### **I. Objection to the Disclosure**

The Examiner has objected to the disclosure for containing certain informalities. The typographical error pointed out by the Examiner at page 7, line 9, has been corrected. Applicants have provided herewith a corrected Figure 1 as requested. Withdrawal of this objection is respectfully requested.

#### **II. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph**

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner suggests that claim 1 is indefinite in recitation of "said mutation" on line 3 as there is no antecedent basis. Applicants have amended the claim to reflect a

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proper antecedent basis. Withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims Under 35 U.S.C. 112, First Paragraph**

Claims 1 and 10 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner acknowledges that the specification is enabling for compositions and methods involving a human H1 enzyme retaining activity by changing Lys to Ala at both positions 226 and 227, deleting all of region I or II, or deleting all of regions I and II. However, the Examiner suggests the specification is not enabling for any and all mutations as it would not be known if a mutation is successful until the change is actually made. Applicants have amended the claims as suggested by the Examiner to reflect that the instant invention comprises mutant human RNase H1 entities that have either a mutation of Lys to Ala at both positions 226 and 227, have all of region I or II deleted, or have all of regions I and II deleted. Accordingly, the amended claims are enabled by the teachings in the specification as filed

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and meet the requirements of 35 U.S.C. 112, first paragraph.  
Withdrawal of this rejection is respectfully requested.

#### IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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Date: September 14, 2004

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